

Remarks:

Status of Claims

New claims 12-18 have been added to more distinctly claim the invention, such that claims 1-18 are currently pending in the application.

Remarks

In the Office Action, the Examiner:

rejected claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,854,774 (hereinafter referred to as "Timme") in view of U.S. Patent No. 4,379,640 (hereinafter referred to as "Inoue"); and

rejected claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Timme and Inoue in further view of U.S. Patent No. 5,444,673 (hereinafter referred to as "Mathurin").

The Examiner does not identify any one prior art reference that discloses all of the numerous advantageous features of the present invention. The Examiner, in rejecting the originally filed claims, is instead forced to rely on the combination of a number of prior art references. Furthermore, as none of the cited prior art references expressly or implicitly suggest such combinations, the Examiner is forced to assert obviousness as the basis for the combinations. Obviousness, it will be appreciated, is a problematic basis for rejection, particularly because the Examiner, in determining that features are obvious, has the benefit of the Applicant's disclosure as a guide, whereas one with ordinary skill in the art would have no such guide. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection.

MPEP §2142 states that the Examiner bears the initial burden of establishing a *prima facie* case of obviousness, which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. MPEP §2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination", and, furthermore, "if the proposed modification would render the prior art

invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

Timme discloses a medical timing system 10 for assisting medical personnel in providing efficient and safe medical care to patients while decreasing the level of stress experienced by the medical personnel by allowing for the monitoring of up to five different patient activities simultaneously. It is an expressed object of Timme to decrease the stress of medical personnel. See col. 2, lines 45-46. Thus, both expressly and implicitly Timme is designed and contemplated for use in a particular context and environment involving patient care.

The system 10 comprises a housing structure 20; a power supply 50 secured within the housing structure 20; a timing means 30 electronically connected to the power supply 50 and secured to the housing structure 20; and a securing means 40 mounted to a rear exterior surface of the housing structure 20. The timing means 30 includes a central processing unit 76; a plurality of time set buttons 37; a plurality of preset time buttons 39; a first LED display 31, a second LED display 32, a third LED display 33, a fourth LED display 34, and a fifth LED display 35; a start button 79 and a stop button 80; a central LED clock 36; an HR-RR LED display 38; and a set key 72 protected by a set button guard 74 for preventing accidental manipulation of programmed information in the central processing unit 76.

In use, the user programs the central processing unit 76 by first pressing the set key 72 to allow the user to program the central processing unit 76. The user then presses the plurality of time set buttons 37 to set the preferred time for each of the five individual timers. The user then presses the set key 72 again to start the timing and to prevent accidental manipulation of the programmed preferred time. When the central processing unit 76 determines that one of the timers have expired, it activates a speaker 78 which gains the user's attention.

Timme fails to disclose a number of advantageous features provided by the present invention, including, for example, the feature of allowing the alarm to be set and the timing function initiated with the push of a single button. By contrast, Timme requires that at least three buttons be pushed, including first the set button to allow for programming the central processing unit, then one or more time set buttons to set the preferred time, and lastly the

set button again to start timing and to prevent accidental reprogramming of the preferred time. Timme requires this additional complexity because of the use it is put to and the importance of its timekeeping function. Thus, for example, Timme requires inclusion of the set button to protect against reprogramming because Timme is designed for use in a patient care environment where extremely accurate timekeeping may be necessary for life, health, and other safety reasons and where bumping or jarring of the timing system, being worn or carried on the medical personnel's person, might otherwise lead to reprogramming. Thus, Timme would not function as it was designed to or meant to without the aforementioned added complexity. Such added complexity, however, is a nuisance in applications for which the present invention is designed and contemplated. More specifically, the present invention is designed for measuring a limited selection of discrete periods of time, and the device is not meant to be worn or carried and therefore is at substantially less risk of being reprogrammed. Thus, Timme does not disclose the present invention's advantageous feature of one-button combined programming and automatic initiation of a timed period; nor can it be said to suggest such a feature because one-button combined programming and initiation does not provide any protection against accidental reprogramming and such protection is necessary to Timme.

Furthermore, as the Examiner admits, Timme does not disclose the "announcement of data relating to the operating mode of a timepiece by means of synthesized human speech". In rejecting this feature of the present invention, the Examiner is forced to rely upon the combination of Timme and Inoue. As stated by the Examiner, "[o]ne skilled in the art having both references would be taught that the operative modes of the timer in Timme may be audibly announced by means of audible speech, as done in the timekeeping of Inoue, as an additional means of confirming data selection".

The Examiner is reminded, however, that an expressed object of Timme is to reduce the stress of medical personnel and to provide for the monitoring of multiple patients. It will surely be appreciated that the audible confirmations of potentially frequent programming in a patient-care environment would add to rather than reduce the stress on medical personnel. Furthermore, in a patient-care environment the audible confirmations would be highly undesirable, particularly from the standpoint of adding to or producing undue noise which might wake or otherwise upset patients. Thus, the Applicant asserts that it cannot

be said to be obvious to combine Timme with Inoue to provide this feature of the present invention because doing so would render Timme unsuitable for accomplishing its expressed and implied objects and purpose.

Furthermore, Timme does not disclose the feature of recording, storing, and playing back audible messages at the end of the timed period. Thus, in rejecting claims 6-11, the Examiner is forced to rely upon the combination of Timme, Inoue, and Mathurin, wherein Mathurin is asserted to disclose the feature in question. As stated by the Examiner, "[o]ne skilled in the art would thus be taught to provide this feature in the timer of Timme as a further convenient feature for alarm time announcement".

The Examiner is again reminded, however, that an expressed object of Timme is to reduce the stress of medical personnel and to provide for the monitoring of multiple patients. It will surely be appreciated that the audible announcement of up to five messages at once would add to rather than reduce the stress on medical personnel. Furthermore, in a patient-care environment the unexpected announcement of audible messages would be highly undesirable, both from the standpoint of violating patient confidentiality and from the standpoint of adding to or producing undue noise which might wake or otherwise upset patients. Thus, the Applicant asserts that it cannot be said to be obvious to combine Timme with Mathurin to provide this feature of the present invention because doing so would render Timme unsuitable for accomplishing its expressed and implied objects.

In light of the foregoing discussion, the Applicant respectfully asserts that the Examiner has failed to establish the required *prima facie* case for obviousness, and, furthermore, that no such case can be established because the asserted combinations of references would render one or more of the cited references unsuitable for its intended purpose.

Furthermore, MPEP §2141.02 states that the invention as a whole must be considered and not merely the constituent parts or features independent of the whole. Thus, in the present case, it is not enough to combine bits and pieces of a number of different prior art references to arrive at a rejection of the present invention. Instead, the present invention as a whole must be considered in light of the prior art. In the present case, Timme combined with Inoue combined with Mathurin, even if such a combination

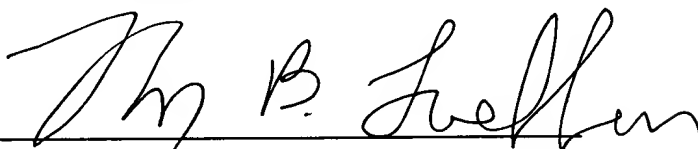
were permissible, would not result in the present invention as a whole, but rather a substantially more complex solution lacking the simplicity of form and function which makes the present invention novelly and non-obviously suited to its purpose.

New claims 12-18 have been added to more distinctly claim the invention. More particularly, new independent claim 12 includes the limitation of automatic initiation of the measurement period; new independent claim 15 includes the aforementioned limitation of claim 12 and introduces the additional limitation of a controller operable to provide feedback signals relating to the operation of and operative mode of the timing device; and new independent claim 18 introduces the limitation of setting the timing device using only multiples of discrete time units, specifically including units of fifteen minutes and one hour, and the further limitation of an ear-phone jack wherein the speaker is disabled while the ear-phone jack is in use. None of the cited prior art references disclose or suggest the present invention as claimed in new claims 12-18, nor can Timme be modified to arrive at the claimed invention because doing so would make Timme unsuitable for its expressly and implicitly stated objects and purpose.

Thus, as the Applicant believes currently pending claims 1-18 to be in condition for allowance, the Applicant respectfully requests a corresponding Notice of Allowance.

In the event of any questions, the Examiner is urged to call the undersigned at 1-800-445-3460. Any additional fee which might be due in connection with this application should be applied against our Deposit Account No. 19-0522.

Respectfully Submitted,
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